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**PATENT, TRADEMARK
& COPYRIGHT LAW**

October 14, 2004

- a) Express Mail Filing Date Certificate of Mailing under 37 CFR 1.10;
- b) 1 Original United States Court of Appeals for the Federal Circuit Petition for Review;
- c) 1 copy – Board of Patent Appeals and Interferences Decision on Appeal;
- d) A stamped return receipt postcard.

Signature: [Signature]
 Print Name: Matt Jellett
 DATE MAILED: September 24, 2004

United States Court of Appeals for the Federal Circuit

Alvin L. Neeley, et al.

Petitioner or Appellant

v. **PETITION/APPEAL FOR REVIEW**

Commisioner for
Patents and Trademarks,
Attn: Office of the Solicitor

Respondent or Appellee

Alvin L. Neeley hereby petitions/appeals the court to/for review of the DECISION ON APPEAL of the BOARD OF PATENT APPEALS AND INTERFERENCES, entered on August 16, 2004.



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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

AUG 23 2004

Ex parte ALVIN L. NEELEY
and
STEVEN M. DAVIS

Appeal No. 2004-1521
Application No. 09/440,149

MAILED

AUG 16 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before KIMLIN, OWENS, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1, 3 through 9, and 13 (final Office action mailed Jul. 16, 2002) in the above-identified application. The statuses of the other pending claims are as follows:

- (i) claims 11, 12, and 14-20 - withdrawn from further

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consideration pursuant to 37 CFR § 1.142(b) (2003)
(effective Dec. 22, 1959);

- (ii) claim 10 - objected to as being dependent upon a rejected base claim but considered otherwise allowable if rewritten in independent form; and
- (iii) claim 21 - allowed.

The subject matter on appeal relates to a lifting assembly, i.e., "an apparatus...for lifting and removing larger and heavier objects which are at least moderately awkward to handle..." (Specification, page 1, lines 5-8.) Further details of this appealed subject matter are recited in representative claim 1 reproduced below:

1. A lifting assembly arranged to lift an object which has a width dimension and is at least partially surrounded by a base surface which has a substantial horizontal alignment component, such as a manhole cover surrounded by a paved or ground surface, said assembly comprising:

- a) a base support assembly comprising:
 - i) a beam structure which has a lengthwise axis, is adapted to be positioned above the object, and has a length dimension greater than the width dimension of the object, said beam structure having a first pivot end and a second mobile end spaced from one another a sufficient distance so that the beam structure can be placed over the object to be lifted, with the first and second ends engaging the base surface in load bearing relationship on opposite sides of the

- object to be lifted, said beam structure being the primary load carrying structure relative to the object to be lifted;
- ii) a pivot support connected to the beam structure and located at the pivot end thereof, and arranged to support the pivot end of the beam structure from the base surface and to engage the base surface in a manner to resist movement of the pivot support from a substantially stationary base surface pivot location on one side of the object to be lifted during movement of the lifting assembly;
 - iii) a mobile support connected to the beam structure and located at the mobile end thereof, and arranged to support the mobile end of the beam structure from the base surface on an opposite side of the object to be lifted, said mobile support having a mobile base surface engaging portion to enable the mobile support to be moved laterally over the base surface;
- (b) a lifting mechanism mounted to the beam structure between the pivot support and the mobile support and comprising a lift connection to engage said object and an actuator acting through said lift connection to lift said object whereby said lifting assembly can be positioned over said object with the pivot support being on one side of said object and the mobile support being on an opposite side of said object, so that said lifting mechanism is able to raise said object, and the mobile support of said lifting assembly can be moved laterally so as to move said object about said pivot support.

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The examiner relies on the following prior art references as evidence of unpatentability:

Schaller	4,662,526	May 05, 1987
Schmitz et al. (Schmitz)	5,035,336	Jul. 30, 1991
Blunt (GB '017) (published GB application)	GB 2 111 017 A	Jun. 29, 1983

Claims 1, 3 through 9, and 13 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Schmitz in view of Schaller. (Examiner's answer mailed Jan. 8, 2004, pages 3-4.) In addition, claims 1, 3 through 9, and 13 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over GB '017 in view of Schaller. (Id. at 4.)¹

We affirm both rejections. Because we are in complete agreement with the examiner's factual findings and legal conclusions, we adopt them as our own and add the following comments for emphasis.²

¹ The examiner indicates that all other rejections as set forth in the final Office action have been withdrawn. (Answer at 2, referring to the appeal brief filed Sep. 17, 2003, pp. 6-7.) Also, it appears that the examiner inadvertently included canceled claim 2 in the statements of rejection as set forth in the answer.

² The appellants submit that the appealed claims are separately patentable as follows: (i) claims 1, 3, and 13; (ii)

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Schmitz describes a manhole cover lifter 10 including, inter alia: a frame 12; sets of legs 16, foot plates 22, and wheels 58 at either end of the frame 12; and a device for lifting the manhole cover. (Column 2, line 50 to column 3, line 35; Figure 1.) According to Schmitz, each of the wheels is preferably provided with a lock 62. (Column 3, lines 35-36.)

Schaller describes "a hoisting apparatus for a cover of an electric arc furnace or similarly bulky object." (Emphasis added; column 1, lines 11-13.) In Figure 1, Schaller teaches a hoisting apparatus including, inter alia, a pulling or hoisting rod 11, a traverse bar 17, a gantry arm 6, a locking support bar 18, a vertical support member 5, a gantry 4, support pin 20, and wheel 21. (Column 2, line 62 to column 3, line 34.) Schaller further suggests that the locking support bar 18, in cooperation with support pin 20 and wheel 21, allows rotation of the gantry arm 6 as the cover is lifted. (Column 2, lines 34-39.)

claims 4 and 5; (iii) claim 6; and (iv) claims 7-9. (Appeal brief at 7.) In the "ARGUMENTS" section, the appellants merely identify the further limitations recited in claims 4, 6, and 7. We point out, however, that "[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." See 37 CFR § 1.192(c)(7)(2003) (effective Apr. 21, 1995). Accordingly, we hold that all claims stand or fall together and limit our discussion to representative claim 1.

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From the collective teachings of the references, the examiner determined (answer at 4) that "[i]t would have been obvious [to one of ordinary skill in the art] to use wheels at one end and a non-wheeled pivot at the other end of the mechanism in Schmitz in view of the teaching in Schaller because it would permit one to more easily move the cover to the side of the manhole and back over the manhole." (Id.)

We agree with the examiner's analysis. Schaller suggests that the wheel 20 and support pin (i.e., pivot) 21 allows rotational movement of the gantry arm 6, which in turn would permit the easy removal and placement of the cover to be lifted. Moreover, as we discussed above, Schmitz teaches that each set of wheels 58 at either end of the frame 12 is both mobile (when lock 62 is disengaged) and stationary (when lock 62 is engaged). Giving the term "pivot support" as recited in appealed claim 1 its broadest reasonable interpretation consistent with the specification description (e.g., page 10, lines 12-19),³ we

³ In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."); In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) ("The PTO broadly interprets claims during examination of a patent application since the applicant may amend his claim to obtain protection commensurate with his

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determine that Schmitz describes each and every limitation of the invention recited in appealed claim 1. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).⁴

The appellants argue that "[t]he preferred configuration [in Schmitz] is that the wheels be non-castering so that these can be guided along a straight line." (Appeal brief at 35.) As acknowledged by the appellants, however, the use of non-castering wheels is merely a preferred embodiment. (Column 3, lines 30-35.) On this point, it has long been held that all of the disclosures of a prior art reference, including non-preferred embodiments, must be considered for what they fairly teach one of ordinary skill in the art. Merck & Co. Inc. v. Biocraft Labs. Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Fracalossi, 681 F.2d at 794 n.1, 215 USPQ at 570 n.1; In re Lamberti, 545 F.2d 747, 750, 192 USPQ

actual contribution to the art.'" (quoting In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

⁴ While the examiner's rejection of appealed claim 1 has been made under 35 U.S.C. § 103(a), a prior art disclosure that includes a complete description of the claimed invention also renders the claim obvious, for anticipation is the epitome of obviousness. In re Baxter Travenol Laboratories, 952 F.2d 388, 391, 21 USPQ2d 1281, 1284-85 (Fed. Cir. 1991); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re May, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978).

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278, 280 (CCPA 1976); In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966).

In addition, the examiner relies on the collective teachings of Schmitz and Schaller. In re Keller, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981) ("[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.").

The appellants appear to be urging that Schaller is non-analogous art. (Appeal brief at 38-39; reply brief filed Mar. 3, 2004.) This position lacks merit. The test for determining whether a prior art reference is analogous is as follows: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the inventor's endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Regarding the second prong of this two-part test, our reviewing court has explained:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in

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determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention.

In re Clay, 966 F.2d at 659, 23 USPQ2d at 1061.

In this case, we find that Schaller's teachings are not necessarily limited to a hoisting apparatus for a cover of an electric arc furnace. As we pointed out above, Schaller expressly teaches that the hoisting apparatus may be used to lift and move a "similarly bulky object." (Column 1, lines 11-13.) While the appellants would have us believe that their claimed invention is limited to an apparatus for a manhole cover, this belief is contradicted by the appellants' own disclosure, which plainly states that the "[t]he present invention relates to an apparatus and method for lifting and removing larger and heavier objects which are at least moderately awkward to handle..." Under these circumstances, it cannot be said that the present invention and Schaller are from different fields of endeavor.

Even if we assume that Schaller is not from the same field of endeavor, the result of our analysis would be the same.

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Schaller suggests the use of a pivot and wheel combination for the same reason discussed in the present specification.

(Schaller's column 2, lines 34-39; present specification, page 5, lines 20-28.) Thus, Schaller's disclosure is also reasonably pertinent to the problem with which the inventors are involved.

For these reasons, we uphold the examiner's rejection based on the combination of Schmitz and Schaller.

As to the rejection based on the combination of GB '017 and Schaller, the examiner finds that GB '017 describes every limitation of the invention recited in appealed claim 1 except that the disclosed manhole cover lifting device does not include "a mobile support." (Answer at 4.) Nevertheless, the examiner correctly determined that "[i]t would have been obvious [to one of ordinary skill in the art] to provide wheels to the plates 34 at the lower ends of supports 22 and 23 in the British reference in view of the teaching in Schaller because it would permit one to more easily move the cover to the side of the manhole and back over the manhole." (Id.)

The appellants argue that GB '017 teaches an apparatus having only stationary supports. (Appeal brief at 36.) We point out, however, that the examiner's rejection is not based

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on GB '017 alone but rather on the combined teachings of GB '017 and Schaller. In re Keller, 642 F.2d at 426, 208 USPQ at 882.

The appellants' position regarding Schaller for this ground of rejection is unpersuasive for the same reasons discussed above in connection with the ground of rejection based on Schmitz and Schaller.

The appellants contend that the claimed invention solves a problem in the art, namely the problem of back injuries in the art of removing manhole covers. (Appeal brief at 7-18 and 42-47.) We note, however, that appealed claim 1 is not limited to an apparatus for removing manhole covers. Moreover, none of the appellants' arguments or relied upon declaration evidence contain any objective evidence (e.g., comparative data) or reasoning establishing that the prior art apparatuses are incapable of solving the same problem.

For these reasons, we affirm the examiner's rejection based on the combined teachings of GB '017 and Schaller.

In summary, we affirm the examiner's rejections under 35 U.S.C. § 103(a) of appealed claims 1 through 9 and 13 as unpatentable over: (i) Schmitz in view of Schaller; and (ii) GB '017 in view of Schaller.

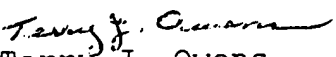
The decision of the examiner is affirmed.

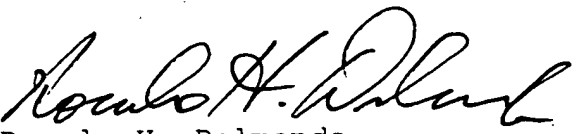
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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


Edward C. Kimlin)
Administrative Patent Judge)


Terry J. Owens)
Administrative Patent Judge)


Romulo H. Delmendo)
Administrative Patent Judge)

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